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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,054	10/17/2003	Samuel Sergio Tenenbaum		9221

7590
United Virtualities, Inc.
116 West 23rd Street
Suite 500
New York, NY 10011

12/16/2009

EXAMINER

CHENEY, BOBAE K.

ART UNIT	PAPER NUMBER
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2458

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/688,054	TENEMBAUM, SAMUEL SERGIO	
	Examiner	Art Unit	
	BOBAE K. CHENEY	2458	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/17/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 – 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (US Patent 5,991,735).

3. Regarding to **claim 1**, “In a computer network including a user's computer and a control server connected for communication, the user's computer running an e-mail program and a browser program, a method for integrating e-mail and browser communications with the user, comprising the steps of: in an initial HTML e-mail communication with the user over the network, embedding a signal which, upon operation of the HTML on the user's computer, causes transmission to the control server of an ID code signal available at the user's computer and uniquely associated with the user or his computer and, upon receiving the ID code signal at the control server, storing it at the server in association with information related to the user available to the control server,” Gerace teaches program controller in web server (control server) assigning a unique users computer ID (signal), which is used to obtain user's identification information [Column 5 Line 27 – 42]. The web server is able to provide email program to user (HTML e-mail communication) [Column 10 Line 48 – 63]. Gerace does not expressly teach user's computer running an e-mail program and a

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browser program. However, it is obvious that in order to receive services from server, such as email, the user computer needs e-mail program and browse program in order to display the e-mail messages. "In a subsequent HTML communication with the user over the network, embedding a signal which, upon operation of the HTML on the user's computer, causes transmission to the control server of the ID code signal and receiving the same at the control server, and making use of the ID code signal, recovering information about the user available to the control server and, using that information, preparing a response for transmission to the user's computer" Gerace teaches program controller responding to user selections (response for transmission) by obtaining and displaying the requested information [Column 5 Line 27 – 42].

4. Regarding to **claim 2**, "wherein the e-mail program and browser program can both read and write cookies, the ID code signal being saved on the user's computer in a cookie," Gerace teaches user's identification number (ID code signal) stored in cookie (write) and passed (read) by user's computer [Column 7 Line 4 - 15].

5. Regarding to **claim 3**, "wherein the cookie is created at the control server and is updated after an HTML communication from the user to the control server, is sent to the user's computer in response to the HTML communication, and is saved therein," Gerace teaches mail routine, which is in control server, building cookie and transmitting cookie to the user's PC for storage and future use [Column 14 Line 17 – 26].

6. Regarding to **claim 4**, "wherein the control server stores a mailing list containing the identity of users and an ID code signal uniquely identified with each user, the mailing list being used to generate the initial HTML e-mail," Gerace teaches sending

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alerts to users using email [Column 21 Line 47 – 51, Column 22 Line 7 – 9]. In order to send emails to users, the control server needs to have information about user and their email address.

7. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace as applied to claim 3 above, and further in view of Massarani (US Publication 2003/0158889).

8. Regarding to **claim 5**, Gerace teaches cookies, but does not expressly teach “wherein the cookie contains a history of prior information sent to the user.” However, Massarani teaches cookie containing user identification, personalization, and past history information [Paragraph 46]. It would have been obvious to one of ordinary skill in the art at the time of the invention to add history information of user taught by Massarani in cookie taught by Gerace for the purpose of provide user better service. With history information of user, the server can provide more personalized information to user.

9. **Claims 6 – 8, 10 – 12, and 14 – 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace as applied to claim 1 above, and further in view of Ng (US Patent 6,640,301).

10. Regarding to **claim 6**, Gerace teaches ID code signal and HTML e-mail communication, but does not expressly teach “wherein the ID code signal is embedded in the initial HTML e-mail and is transmitted from the user’s computer after the initial e-mail is received and opened by the user, the initial HTML e-mail containing executable code which causes the ID code signal to be stored on the user’s computer.” However,

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Ng teaches embedding unique authentication or ID (ID code signal) in e-mail and if the ID does not exist, the server generates ID and sends to sender (user) [Column 7 Line 21 – 35]. In order to user to send e-mail with ID, the user needs to store the ID on the user's computer for future use. It would have been obvious to one of ordinary skill in the art at the time of the invention to embed ID taught by Ng in e-mail taught by Gerace for the purpose of easily recognize the use, which will shorten time for processing the e-mail.

11. Regarding to **claim 7**, “wherein the e-mail program and browser program can both read and write cookies, the ID code signal being saved on the user's computer in a cookie,” Gerace teaches user's identification number (ID code signal) stored in cookie (write) and passed (read) by user's computer [Column 7 Line 4 - 15].

12. Regarding to **claim 8**, “wherein the cookie is created at the control server and is updated after an HTML communication from the user to the control server, is sent to the user's computer in response to the HTML communication, and is saved therein,” Gerace teaches mail routine, which is in control server, building cookie and transmitting cookie to the user's PC for storage and future use [Column 14 Line 17 – 26].

13. Regarding to **claim 10**, “wherein the control server stores a mailing list containing the identity of users and an ID code signal uniquely identified with each user, the mailing list being used to generate the initial HTML e-mail,” Gerace teaches sending alerts to users using email [Column 21 Line 47 – 51, Column 22 Line 7 – 9]. In order to send emails to users, the control server needs to have information about user and their email address.

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14. Regarding to **claim 11**, “wherein the e-mail program and browser program can both read and write cookies, the ID code signal being saved on the user's computer in a cookie,” Gerace teaches user's identification number (ID code signal) stored in cookie (write) and passed (read) by user's computer [Column 7 Line 4 - 15].

15. Regarding to **claim 12**, “wherein the cookie is created at the control server and is updated after an HTML communication from the user to the control server, is sent to the user's computer in response to the HTML communication, and is saved therein,” Gerace teaches mail routine, which is in control server, building cookie and transmitting cookie to the user's PC for storage and future use [Column 14 Line 17 – 26].

16. Regarding to **claim 14**, “wherein the control server is an Ad server which provides online advertising to users and selects advertising signals for transmission to a user based on the ID code signal received from the user,” Gerace teaches advertisement module (ad server) providing advertisement based on user's preferences [Column 5 Line 43 – 53]. In order to provide advertisement based on user's preferences, the server needs to be recognized, such as ID.

17. **Claim 16** is equivalent to claim 14. Therefore, claim 16 is rejected under the same rationale.

18. Regarding to **claim 15**, “wherein the control server selects advertising signals for transmission to a user based on information present in the cookie stored on the user's computer,” Gerace teaches using cookie to identify user's preferences [Column 13 Line 59 – Column 14 Line 2].

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19. **Claims 17 and 18** are equivalent to claim 15. Therefore, claim 18 is rejected under the same rationale.

20. **Claim 9 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace and Ng as applied to claim 6 and 12 above, and further in view of Massarani (US Publication 2003/0158889).

21. Regarding to **claim 9**, Gerace teaches cookies, but does not expressly teach “wherein the cookie contains a history of prior information sent to the user.” However, Massarani teaches cookie containing user identification, personalization, and past history information [Paragraph 46]. It would have been obvious to one of ordinary skill in the art at the time of the invention to add history information of user taught by Massarani in cookie taught by Gerace for the purpose of provide user better service. With history information of user, the server can provide more personalized information to user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOBAE K. CHENEY whose telephone number is (571)270-7641. The examiner can normally be reached on Monday - Thursday 7:30 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Joseph Avellino can be reached on (571)272-3905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BOBAE K CHENEY
Examiner
Art Unit 2458

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Examiner, Art Unit 2458

/Joseph E. Avellino/
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